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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,329	11/14/2003	Hector Ray Hernandez JR.	9429	9489

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CONNORS ASSOCIATES
1600 DOVE ST
SUITE 220
NEWPORT BEACH, CA 92660

EXAMINER

TALBOT, MICHAEL

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/714,329	Applicant(s) (6) HERNANDEZ, HECTOR RAY	
	Examiner Michael W Talbot	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-18 and 22-34 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 19-21 and 35-38 is/are rejected.
- 7) ☒ Claim(s) 6, 7 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

Refer to page 9, line 13, insert a space between the text "bit 12." and "The".

Refer to page 17, lines 4 and 6, the two occurrences of character reference "drill element 22" should be change to read --drill element 16--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claim 5, the phrase "said drill element being received in the cut-a-way section" is contradictory with the limitation claimed in claim 1, from which it depends, by the phrase "said cutting end being adjacent to the drill element". The plate member has two ends, a cutting end with a pointed tip and an opposing end with a cut-a-way section. It is unclear as to how the drill element can be both "received in the cut-a-way section" of the plate member described in claim 5 and also be "adjacent to the cutting end" of the plate member described in claim 1. Furthermore, the specification and associated figures do not provide support for the plate member/drill element orientation described in claim 5.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Vasudeva et al. '268. Vasudeva et al. '268 shows in Figures 2 and 20 a drill bit (400) having a drill element (401), a driver element (402) and a plate element (800) with a cutting end (802) being assembled together with the plate member being intermediate the drill element and the driver element and with the cutting end of the plate element being adjacent to the drill element.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5,8,19 and 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al. 2004/0232631. Chen et al. 2004/0232631 shows in Figures 6-11 a drill bit (50) having a drill element (54), a driver element (56) and a plate element (52) with a cutting end being axially aligned and assembled together with the plate member being intermediate the drill element and the driver element and with the cutting end of the plate element being adjacent to the drill element. Chen et al. 2004/0232631 further shows both drill and driver elements having an elongated axial groove therein for receiving a portion of the plate member. Chen et al. 2004/0232631 shows in Figures 1,3 and 11 a connect-disconnect coupling (20) having a spindle body (10) with an open mouth cavity (15) at one end and a slot (18) intersecting the longitudinal axis of the spindle body and the cavity, wherein the cavity is configured to receive the driver element of the drill bit.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. '2004/0232631 in view of Zierpka et al. '815. Chen et al. 2004/0232631 is silent to the bonding mechanism used between the parts. Zierpka et al. '815 shows in Figures 5 and 6 that the connecting members (26,27) are positively engaged to an intermediate member (30). Zierpka et al. '815 further shows in col. 7, lines 11-13 that once assembled the parts can further be solidly joined. In view of this teaching of Zierpka et al. '815, it is considered to have been obvious to replace the engaging mechanism of Chen et al. 2004/0232631 with another well-known, positively engaging mechanism of friction and/or alternate bonding.

Allowable Subject Matter

5. Claims 6,7,9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 10-18 and 22-34 are allowed.

Chen et al. '2004/0232631 is the closest art of record.

Claims 10,11,22 and 30 are the independent claims. Regarding claim 10, Chen et al. '2004/0232631 lacks a cavity at one end of the drill and driver elements such that the other element can be inserted into the cavity. There is no suggestion to modify Chen et al. '2004/0232631 to include the cavity feature.

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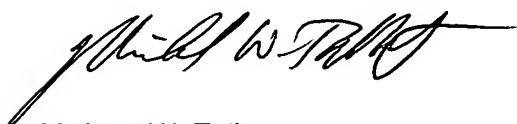
Regarding claim 11, Chen et al. '2004/0232631 lacks a cavity at one end of the driver element such that the drill element can be inserted into the driver cavity. There is no suggestion to modify Chen et al. '2004/0232631 to include the cavity feature.

Regarding claim 22, Chen et al. '2004/0232631 lacks a cavity at one end of the driver element, a groove at the same end intersecting the driver cavity and a longitudinal slot at the tapered end of the plate member. There is no suggestion to modify Chen et al. '2004/0232631 to include these features.

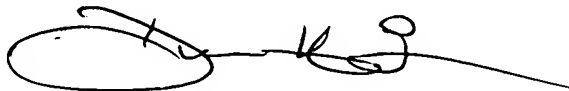
Regarding claim 30, Chen et al. '2004/0232631 lacks a cavity at one end of the driver element and a groove at the same end intersecting the driver cavity. There is no suggestion to modify Chen et al. '2004/0232631 to include these features.

7. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mr. Derris Banks, may be reached at 571-272-4419.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 703-872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.



Michael W. Talbot
Examiner
Art Unit 3722



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3722